

REMARKS

In the Office Action mailed on May 23, 2003, claims 1, 3, 5-8, 12, 14-16, and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Watanabe in view of Shinagawa (U.S. Patent No. 5,276,903) ("Shinagawa"); and claim 4 was objected to as being dependent upon a rejected base claim. The foregoing objections and rejections are respectfully traversed.

Claims 1, 3-8, 12, 14-16, and 18 are pending in the subject application, of which claims 1, 12, and 18 are independent claims.

Entry of Amendment After Final Rejection:

The Applicant respectfully asserts that the amendments presented herein require only a cursory review by the examiner, and respectfully requests that the examiner enter such amendments.

Amendments to the Claims:

Claim 1 is amended herein to correctly recite the feature that was amended into claim 12 in the March 6, 2003. The Applicant apologizes for any confusion. Care has been exercised to avoid the introduction of new matter.

Rejections of the Claims:

Differences Between The Claimed Invention And The Cited References:

The "data" in Watanabe is not similar to the "applications" in the present invention, contrary to the assertion by the examiner on page 5 of the Office Action. In addition, the "data areas" in Watanabe are not similar to the "directory structure" in the present invention, contrary to the assertion by the examiner on page 5 of the Office Action. Further, in the present invention, the management of a plurality of applications is applicable to applications to be executed on an IC card; however, the present invention is not restricted to data in an IC card to be handled by a program, as in Watanabe.

Shinagawa discusses rewriting a program on an IC card. According to Shinagawa,

when a program on an IC card is rewritten, the program is previously divided and address information of the divisions are previously written in a predetermined area, so that the entire IC card does not have to be rewritten. Clearly, Shinagawa differs from the present invention, which relates to enabling the automatic extraction of an application program that is needed for processing a certain file to thereby achieve smooth starting of execution of the relevant file.

Lack Of Motivation To Combine The References:

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." Dembiczak, 50 USPQ2d at 1617. "The factual inquiry whether to combine the references must be thorough and searching." In re Lee, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) (citing McGinley v. Franklin Sports, Inc., 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). The factual inquiry must be based on objective evidence of record, and cannot be based on subjective belief and unknown authority. Id. at 1433-34. The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The Examiner has not presented any evidence why Watanabe and Shinagawa would have been combined. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01. Specifically, there must be a suggestion or motivation in the references to make the combination or modification. Id. The Examiner's sole support for such a combination is that the combination "would improve the accuracy and the reliability of the application managing method and information processing apparatus using the method, and provide an IC card and a method for rewriting its program in which after a program is recorded in a plurality of divided programs in a memory area" (Office Action, p. 4). The Examiner cannot rely on the benefit of the combination without first supporting the motivation to make the

combination. Such motivation does not appear anywhere in either reference, and the Examiner has not presented any actual evidence in support of the same. Instead, the Examiner relies on broad conclusory statements, subjective belief, and unknown authority. Such a basis does not adequately support the combination of references; therefore, the combination is improper and must be withdrawn.

Conclusion:

Therefore, independent claims 1, 12, and 18 of the subject application (as amended herein) are patentably distinguishable over the cited references. In addition, dependent claims 3-8 and 14-16 of the subject application are allowable based in part on their dependency, directly or indirectly, from one of independent claims 1, 12, and 18.


Withdrawal of the foregoing objections and rejections is respectfully requested.

There being no further objections or rejections, it is submitted that the application is in condition for allowance, which action is courteously requested. Finally, if there are any formal matters remaining after this response, the examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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